

REMARKS

Restriction Requirement

The Examiner has required the Applicant to elect one of the following inventions for further examination: Group I. Claims 1 – 14, drawn to a fusion polypeptide; Group II. Claims 14 – 25 and 30, drawn to a DNA molecule encoding the fusion polypeptide; Group III. Claims 26 – 29, drawn to a method of producing the fusion polypeptide; Group IV. Claims 31 – 32, drawn to a method of immobilization of a non-TolA polypeptide; Group V. Claims 33 – 34, drawn to a method of purification and isolation of the non-TolA polypeptide; Group VI. Claim 35, drawn to a method of studying interaction properties as a fusion polypeptide in a host cell; Group VII. Claim 36, drawn to a method for high expression of a polypeptide as a fusion polypeptide in a host cell.

Pursuant to the restriction requirement, Applicant elects the invention of Group I, Claims 1 – 36 (as amended) for further examination with traverse.

Applicant respectfully submits that the inventions of Group I – IV satisfy the unity of invention requirement under PCT Rule 13.1 and 13.2. At first, it is respectfully submitted that the International Searching Authority (ISA) and the International Preliminary Examination Authority (IPEA) did not consider that the present application lacks unity of invention under PCT Rule 13.1 and 13.2 (see copies of relevant pages from International Preliminary Examination Report (IPER), the boxes of “lacking unity of invention” was not checked). The Examiner should take the conclusions of the IAS and IPEA into account, when examining the present invention.

Secondly, Applicant respectfully submits that the subject matter of Groups I – VII satisfy the unity of invention requirement, because the amended Claim 1 define “[A] fusion polypeptide for expression in a host cell, wherein the fusion polypeptide has a basic structure, in sequence, an N-terminus, a TolAIII domain or a functional homologue,

fragment, or derivative thereof, a non-TolA protein partner, and a C-terminus, and wherein the fusion polypeptide optionally comprises an affinity purification tag.” Therefore, Claim 1 contains technical features that are not disclosed or suggested by WO 01/21817. According to MPEP 2131, “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

For example, as shown on page 3, line 12 from bottom of the specification, the embodiments of the present invention include the polypeptide with the structure of “N-terminus – TolAIII – Protein partner – C-terminus”. Such structure is not disclosed or suggest by WO 01/21817. The relevant passage on pages 7 – 8 of WO 01/21817 merely describes that a “TolA-fusion may be at the **carboxyterminal end of TolA**” (bottom of page 7, emphasis added). This does not anticipate the whole polypeptide structure as claimed in the present application.

In addition, WO 01/21817 further clarifies the specific embodiment of the examples of “TolA-fusion” on page 8 as deletion or replacement of **D1-binding domain** of TolA. As commonly known to a person of ordinary skill in the art, D1-binding domain of TolA is located at the N-terminus of TolA (see, for example, page 711, right col. bottom of IDS reference AD). This clearly teaches away from the claimed structured as defined in the pending claims. Because Claims 2 – 36 all depend on Claim 1, they all contain such special technical feature. Accordingly, the claims in Groups I – VII satisfy the unity of invention requirement.

Furthermore, according to MPEP 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner has not provided any motivation or expectation of success of modifying the WO 01/21817 to arrive at the present invention. Without establishing a prima facie case of obviousness, the Examiner cannot conclude

that the feature as defined in the claims of the present invention is not a special technical feature that defines a contribution over the prior art.

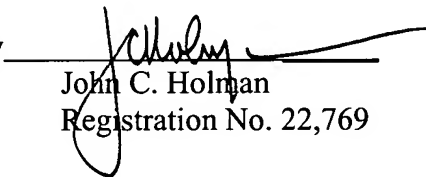
Accordingly, the claims as currently presented contain a special technical feature that defines a contribution over the prior art under PCT Rules 13.1 and 13.2.

An action on the merits of all of the claims and a Notice of Allowance thereof are respectfully requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

Date: July 3, 2006
(202) 638-6666
400 Seventh Street, N.W.
Washington, D.C. 20004
JCH/jc
Atty. Dkt. No.: P69705US0

By 
John C. Holman
Registration No. 22,769